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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215100
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Attachments	6-24-15 Opposer's Opposition to Applicant's Motion for Protective Order.pdf(322635 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EMILIO PUCCI INTERNATIONAL BV,

Opposer,

v.

RANI SACHDEV,

Applicant.

Opposition No.: 91215100

Serial No.: 85913782

Mark: ST. PUCCHI

Filing Date: April 24, 2013

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR PROTECTIVE ORDER

Pursuant to Sections 410 and 526 of the TBMP, Emilio Pucci International BV ("Opposer") hereby opposes Applicant's Motion for Protective Order as inappropriate and untimely. Opposer requests that, pursuant to Federal Rule of Procedure 36(a)(3) and Sections 410 and 527.01(c) of the TBMP, the Board deny Applicant's Motion, find that Applicant has admitted each of Opposer's Requests for Admission and waived any objections on the merits to Opposer's discovery requests, and order Applicant to provide complete responses to Opposer's First Set of Interrogatories and First Set of Document Requests.

I. INTRODUCTION

In filing her Motion for Protective Order, Applicant ignored established TTAB practice and continues her pattern of non-responsiveness and delay. Opposer served its discovery requests on April 30, 2015. (Mot. for Protective Order, TTABVUE #15, Exs. A-C.) On the same day, Opposer sent Applicant's counsel a letter proposing

settlement terms. (Matheson Decl., ¶ 24.) Applicant's counsel delayed contacting counsel for Opposer until the afternoon of the day Applicant's discovery responses were due. At that time, Applicant's counsel requested a thirty (30) day extension of time to respond to discovery without explanation or justification for the delay. (*Id.*, Ex. 1.) When advised that counsel for Opposer could not grant him further extensions without the client's approval, and that, due to the lateness of the hour, Opposer's representatives (located in France and Italy) could not be reached, counsel for Applicant threatened a protective order. (*Id.*, Ex. 6.) Applicant's counsel subsequently followed up with a demand for a seven (7) day extension, and then a three (3) day extension, none of which counsel for Opposer was authorized to grant. (*Id.*, Exs. 2-5.) When Applicant's eleventh-hour attempt to receive an extension failed, she filed this motion in violation of TTAB rules and procedures.

II. ARGUMENT

A. Applicant's Pattern of Delay

The history of this proceeding is informative. Applicant's counsel first contacted Opposer's counsel regarding the potential for settlement in April 2014. (Matheson Decl., ¶ 18.) So that the parties could have an informed discussion about settlement, Applicant's counsel promised to provide Opposer's counsel with documents reflecting Applicant's use of the mark in May 2014 and Opposer consented to a 60-day extension of Applicant's deadline to file her answer. (*Id.*, ¶ 19.) Opposer's counsel followed up with Applicant's counsel twice over the next month asking when Opposer could expect to receive these materials. (*Id.*, Exs. 7, 8.) In June 2014, Applicant's counsel indicated he had gotten "side tracked [sic]" and that he would provide the promised materials

within the week. (*Id.*, Ex. 9.) Applicant's counsel again failed to provide these materials, and Opposer's counsel requested status updates from Applicant's counsel in June and July 2014. (*Id.*, Exs. 10, 11.)

Applicant's counsel waited until the day the answer was due (August 4, 2014) to request another extension of time and again promised to send the materials within the week. (*Id.*, Ex. 12.) Yet again, Applicant's counsel failed to provide the materials as promised, but told Opposer's counsel on August 21, 2014 that he would send the materials "early next week." (*Id.*, Ex. 13.) When Opposer's counsel did not receive these materials by mid-September 2014, she again reached out to Applicant's counsel requesting the materials and detailing his pattern of delay. (*Id.*, Ex. 14.) True to form, Applicant's counsel promised to send the materials "by the end of the week" and again failed to do so. (*Id.*, Ex. 15.) Applicant's counsel finally sent Opposer's counsel the materials on October 29, 2014. (*Id.*, ¶ 20.)

Opposer's counsel sent Applicant's counsel proposed settlement terms on January 29, 2015. (*Id.*, ¶ 21.) When Applicant's counsel did not respond, Opposer's counsel contacted him via email on March 9, 2015 and left him voice messages on March 11 and 18, 2015. (*Id.*, ¶ 22.) On March 20, 2015, Applicant's counsel indicated he would have clarification from Applicant "tomorrow or Monday" and promised to "write further . . . early next week." (*Id.*, Ex. 16.) When Applicant's counsel did not write as promised, Opposer's counsel sent a letter to Applicant's counsel on March 27, 2015 indicating Opposer's unwillingness to tolerate any additional delays in this matter. (*Id.*, ¶ 23.) On April 30, 2015, Opposer served the discovery requests at issue here. (Mot. for Protective Order, TTABVUE #15, Exs. A-C.)

B. Applicant Violated TTAB Rules and Procedures to Avoid the Consequences of Her Continued Delay

The TBMP makes clear that [i]t is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as . . . a motion for a protective order.” TBMP §§ 410, 526. Instead, the governing rules dictate that a party should respond to the requests by stating its objections to those requests it believes are improper and providing the information sought in response to the unobjectionable portions. *Id.*

Applicant seeks a protective order on the grounds that Opposer's discovery requests are overbroad, unduly burdensome, and exceed the scope of discoverable information. Applicant's arguments are unfounded and instead are an improper attempt to avoid the consequences of counsel's continued non-responsiveness and delay. First, Opposer's discovery requests seek the exact type of information that is discoverable in this opposition proceeding, such as information concerning Applicant's (1) goods and services, (2) classes of consumers, (3) selection and adoption of its mark, (4) sales and advertising information and figures, (5) actual knowledge of Opposer and its marks, and (6) trade channels and store locations. *See generally* TBMP § 414. And second, Applicant should have stated her objections in timely responses to Opposer's discovery requests, rather than trouble the Board with this issue. *Id.* §§ 405.03(e), 410, 526.

Applicant should not be rewarded for her continued delay in this proceeding. Applicant had over a month to contact Opposer to discuss settlement and/or request an extension. Instead, her counsel waited until the afternoon of the day discovery responses were due to request an eleventh-hour extension and, when his demands failed, filed this motion in violation of TTAB rules and procedures. Because Applicant

did not respond to Opposer's Requests for Admission within thirty days as required, the governing rules provide that Opposer's requests have been automatically admitted. Fed. R. Civ. P. 36(a)(3); TBMP § 527.01(d). And because Applicant did not respond to Opposer's First Set of Interrogatories or First Set of Requests for Production, she has forfeited her right to object to these discovery requests on the merits. See TBMP §403.03. While this sanction normally arises on the propounding party's motion to compel (see TBMP § 527.01(d)), in the interest of efficiency and judicial economy Opposer requests that the Board make this finding here, rather than require Opposer to file a separate motion to compel.

C. Opposer Did Not Serve Excessive Interrogatories and Applicant Has Forfeited the Right to Object on That Basis

Applicant also seeks a protective order on the basis that Opposer's interrogatories "appear[] to exceed 75." (Mot. for Protective Order, TTABVUE #15.) Opposer disagrees. Applicant has not provided any indication as to how she determined Opposer's 27 interrogatories exceed 75 and she violated TTAB rules and procedures by seeking a protective order on this basis. TBMP § 405.03(e) ("If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number."); TBMP § 410 ("a motion for a protective order is not the proper method for raising the objection of excessive number."). Applicant has therefore waived its objection as to excessive number because she did not serve a timely general objection to Opposer's First Set of

Interrogatories as required by the TBMP, and Opposer respectfully requests that the Board so rule.

III. CONCLUSION

In the interest of efficiency, and for the reasons discussed above, Opposer respectfully requests that the Board deny Applicant's Motion, find that Applicant has admitted each of Opposer's Requests for Admission and waived any objections on the merits to Opposer's discovery requests, and order Applicant to provide complete responses to Opposer's First Set of Interrogatories and First Set of Document Requests.

Date: June 24, 2015

Respectfully Submitted,

By: 

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CERTIFICATE OF SERVICE

This will certify that a copy of the foregoing Opposer's Opposition to Applicant's Motion for Protective Order has been served upon counsel for Applicant via first class mail, postage prepaid, on this 24th day of June 2015, at the following address of record:

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